

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: SCOTT GOLDSWAITE

Application Serial No.: 10/625,823

Filed: 7/23/2003

Attorney Docket No.: WS-102

Title: MOBILE DEVICE EQUIPPED WITH A CONTACTLESS SMART
CARD READER/WRITER

Confirmation No: 7792

ART UNIT 2685

Date Mailed: 4/14/2009

EXAMINER: CHRISTIAN A HANNON

MS Appeal Brief-Patents

Honorable Commissioner for Patents

P.O.Box 1450, Alexandria, VA 22313-1450

APPEAL BRIEF

As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on February 16, 2009, and is in furtherance of the Notice of Appeal.

The fees required under § 41.20(b) (2) are dealt with in the accompanying "TRANSMITTAL OF APPEAL BRIEF" form.

This brief contains items under the following headings as required by 37C.F.R. § 41.37 and M.P.E.P. § 1205.2.

- I. Real Party In Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments

- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument
- VIII. Claims

Appendix A Claims

Appendix B Evidence

Appendix C Related Proceedings

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is Way Systems Inc, a Delaware Corporation, having a place of business at 200 Unicorn Park, Woburn, MA 01801, the assignee of this application.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are fifteen claims pending in this application. Corresponding method claims 16-28 were previously withdrawn.

Claims 1-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Benson (US 6,747,547) in view of Chung (US 7,036,730).

B. Current status of Claims

- 1. Claims withdrawn from consideration: 16-28
- 2. Claims pending: 1-15
- 3. Claims allowed: none

4. Claims rejected: 1-15

C. Claims On Appeal

The claims on appeal are claims 1-15

IV. STATUS OF AMENDMENTS

Appellant did not file an Amendment after the Final Rejection dated November 14, 2008 ("Final Rejection"). Applicant filed a Notice of Appeal on February 16, 2009.

V. SUMMARY OF CLAIMED SUBJECT MATTER

In the discussion below, reference is made to the specification and drawings for exemplary embodiments of the invention covered by the claims. The specification and drawings references are not to be considered as limiting the scope of the invention as defined by the claims.

The claimed invention relates to a wireless mobile device (550, shown in FIG. 1; or 110 shown in FIG. 4) adapted to access a wireless network (90, shown in FIG. 4). Mobile device 550 includes a subscriber identification module (SIM) card slot (552, shown in FIG. 1), and a smart card reader/writer module (500, shown in FIG. 1) electrically connected to the wireless mobile device (550) via the SIM card slot (552). The smart card reader/writer module (500) receives and reads information stored in a smart card (506, shown in FIG. 1) residing outside of the mobile device (550) and outside of the smart card reader/writer module (500) without contacting the smart card (506) (i.e., is a contactless card) and transmit the information to an entity (such as authentication server 107) via the wireless network (90, shown in FIG. 4).

Claim 1

A wireless mobile device adapted to access a wireless network comprising:
a subscriber identification module (SIM) card slot; and

a smart card reader/writer module electrically connected to said wireless mobile device via said SIM card slot; and

wherein said smart card reader/writer module is adapted to receive and read information stored in a smart card residing outside of the mobile device and outside of the smart card reader/writer without contacting said smart card and transmit said information to an entity via said wireless network.

Claims 2-15 depend upon claim 1.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether the rejection of claims 1-15 as being unpatentable over Benson (US 6,747,547) in view of Chung (US 7,036,730) should be reversed.

VII. ARGUMENT

Claims 1-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Benson (US 6,747,547) in view of Chung (US 7,036,730). Applicant respectfully traverses this rejection and it is respectfully suggested that this rejection does not meet the Patent Office's burden of providing *prima facie* showing of unpatentability for the following reasons.

1. Benson does not teach connecting a contactless card reader to a wireless mobile phone. Neither does Chung teach connecting a contactless card reader to a wireless mobile phone or any other analogous wireless device. Accordingly it is concluded that the combination of these two prior art references logically cannot teach connecting a contactless card reader to a wireless mobile phone via the phone's SIM slot.

2. Benson teaches about card readers for contact-type cards and mobile phones. Chung teaches about wired voting machines and that contactless card readers are an option for recording and counting votes in the voting machines. A voting machine is not analogous to a wireless mobile device. Therefore, there is no motivation or reason to

associate and combine the teachings about a wired voting machine with the teachings about a wireless mobile phone.

3. Even if one undertook such a random combination, it is still not obvious that when one connects a contactless card reader to the mobile phone via the SIM slot of the mobile phone, the phone will be able to read information from an external contactless card contactlessly via the contactless reader and then transmit the read information wirelessly to a network, as claimed in claim 1 of the present invention.

4. Furthermore, it is also not obvious that the reverse can occur i.e., data that are wirelessly received by the mobile phone can be contactlessly transmitted and stored in the contactless card, as claimed in claim 2 of the present invention. These functionalities are not obvious and therefore claims 1 and 2 are not obvious over Benson in view of Chung.

5. Furthermore, preservation of voter anonymity is crucial in the voting process and therefore Chung teaches that “the voting information stored in the smart card SC is written over any identifying information relating to the particular voter or such information is erased by the voting machine VM, thereby assuring that identity of the voter cannot be ascertained from the information stored in voting machine VM, in smart card SC and on printed receipt PR” (See column 6, lines 40-46). Contrary to that the present invention teaches identifying and authenticating the user to a remote entity via the information stored in the SIM card of the wireless communication device or in the contactless card. This user identification and authentication is crucial in commerce applications as described in the present invention. Accordingly, it is believed that Chung teaches away from the present invention.

For at least the reasons above the combination of Benson with Chung fails to make obvious the subject matter of claims 1 and 2, and reversal of the rejection of these claims is respectfully solicited. Claims 3-15 depend directly or indirectly upon claim 1. Since

claim 1 is patentable over the combination of Benson with Chung, they should also be patentable over the combination of Benson with Chung.

VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A.

Respectfully submitted,

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I hereby certify under 37 CFR 1.10 that this correspondence is being deposited electronically at the USPTO on the date indicated above and is addressed to the Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450

APPENDIX A

Claims Involved in the Appeal of Application Serial No. 10/625,823

Listing of Claims:

1. (previously presented) A wireless mobile device adapted to access a wireless network comprising:
 - a subscriber identification module (SIM) card slot; and
 - a smart card reader/writer module electrically connected to said wireless mobile device via said SIM card slot; and

wherein said smart card reader/writer module is adapted to receive and read information stored in a smart card residing outside of the mobile device and outside of the smart card reader/writer without contacting said smart card and transmit said information to an entity via said wireless network.
2. (previously presented) The wireless mobile device of claim 1 wherein said smart card reader/writer module is further adapted to receive information from said entity via said network and transmit and write said information in said contactless smart card.
3. (original) The wireless mobile device of claim 1 wherein said information is selected from a group consisting of cardholder identification information, card identification information, authentication information, smart card issuer information, financial institution information, digital goods, digital services, and digital currency.
4. (original) The wireless mobile device of claim 3 wherein said digital goods are selected from a group consisting of electronic cash, electronic coupons, electronic gift certificates, electronic transit tokens, music, software, movies, and books.
5. (previously presented) The wireless mobile device of claim 1 further comprising;

a memory;

 a Central Processing Unit (CPU);

 a SIM card connected to said SIM card slot, said SIM card authenticating said wireless mobile device to said wireless network; and

 a first application program associated with said memory and said CPU and being adapted to receive and transmit instructions from said smart card reader/writer module to said wireless mobile device and the reverse.

6. (previously presented) The wireless mobile device of claim 5 further comprising a second application program associated with said memory and said CPU and being adapted to route and transmit data and information among said wireless mobile device, said smart card reader/writer module, and other interfaces connected to said CPU.

7. (original) The wireless mobile device of claim 6 wherein said other interfaces are selected from a group consisting of smart card interfaces, infrared transceiver interfaces, serial communication interfaces, and magnetic stripe reader interfaces.

8. (previously presented) The wireless mobile device of claim 6 wherein said first and second application programs are stored in storage selected from a group consisting of said CPU, said SIM card, an external SIM card, said smart card, and an external card.

9. (previously presented) The wireless mobile device of claim 1 wherein said smart card reader/writer module further comprises an antenna for receiving and transmitting messages to and from said smart card without contacting said smart card.

10. (original) The wireless mobile device of claim 1 wherein said wireless mobile device is selected from a group consisting of a mobile phone, a personal digital assistant, a pager, a wireless laptop computer, a personal computer, a television remote control, and combinations thereof.

11. (original) The wireless mobile device of claim 1 wherein said wireless network is selected from a group consisting of a wireless wide area network (WWAN), a wireless local area network (WLAN), a private network, and a personal area network (PAN).
12. (original) The wireless mobile device of claim 11 wherein said wireless wide area network (WWAN) is selected from a group consisting of a Global System for Mobile Communications(GSM), a Code Division Multiple Access(CDMA), CDMA 2000, and wideband CDMA(WCDMA).
13. (previously presented) The wireless mobile device of claim 1 wherein said wireless mobile device is used for making financial transactions between a user and said entity and paying for said financial transactions with said smart card over said network.
14. (original) The wireless mobile device of claim 13 wherein said financial transactions between said user and said entity are face-to-face.
15. (original) The wireless mobile device of claim 13 wherein said financial transactions between said user and said entity are remote.
16. (withdrawn) An electronic communication method comprising:
purchasing a good or a service from a merchant; and
paying with a smart card via a wireless mobile device wherein said smart card resides outside of the mobile device;
wherein said wireless mobile device is adapted to access a wireless network and comprises a subscriber identification module (SIM) card slot and a smart card reader/writer module electrically connected to said SIM card slot and wherein said smart card module is adapted to receive and read information stored in said smart card without contacting said smart card and transmit said information to an entity via said wireless network .

17. (withdrawn) The electronic communication method of claim 16 further comprising receiving said good or service electronically and storing it in said card.

18. (withdrawn) The electronic communication method of claim 14 further comprising retrieving said good or service from said card and redeeming it.

19. (withdrawn) An electronic payment method utilized by a customer to pay a merchant with electronic cash stored in a smart card for a face-to-face purchase of a good or service comprising:

placing an order by said customer for said purchase of said good or service to said merchant;

providing a wireless mobile device wherein said mobile device is adapted to access a wireless network and comprises a subscriber identification module (SIM) card slot and a smart card reader/writer module electrically connected to said SIM card slot and wherein said smart card reader/writer module is adapted to receive and read information stored in said smart card without contacting said smart card and transmit said information via said wireless network;

entering information of said purchase in said wireless mobile phone;

positioning said smart card in close proximity to said smart card reader/writer module, retrieving smart card identification information and authorizing withdrawal of an electronic cash amount for payment for said good or service from said smart card;

sending said purchase information, said smart card identification information and said electronic cash amount to an authentication server via said wireless network;

authenticating and sending said purchase information and said electronic cash amount by said authentication server to a business account of said merchant held in a financial institution;

registering said purchase information and depositing said electronic cash amount to said merchant's business account and sending confirmation by said financial institution to said authentication server;

forwarding said confirmation to said wireless mobile phone; and

fulfilling said order to said customer by said merchant.

20. (withdrawn) An electronic payment method utilized by a customer to pay a merchant with a smart card for a face-to-face purchase of a good or service comprising:

placing an order by said customer for said purchase of said good or service to said merchant;

providing a wireless mobile device wherein said wireless mobile device is adapted to access a wireless network and comprises a subscriber identification module (SIM) card slot and a smart card reader/writer module electrically connected to said SIM card slot and wherein said smart card reader/writer module is adapted to receive and read information stored in said smart card without contacting said smart card and transmit said information via said wireless network;

entering information of said purchase in said wireless mobile phone;

positioning said smart card in close proximity to said smart card reader/writer module, retrieving smart card identification information from said smart card and authorizing payment for said good or service;

formatting said purchase information, said smart card identification information and said payment authorization into a first message and sending said first message to an authentication server via said wireless network;

authenticating and sending said first message by said authentication server to a financial institution;

registering said purchase information and sending approval for said payment by said financial institution to said authentication server;

forwarding said payment approval to said wireless mobile phone; and

fulfilling said order to said customer by said merchant.

21. (withdrawn) The electronic payment method of claim 20 wherein said first message comprises a format selected from a group consisting of Short Message Service (SMS), General Packet Radio Service (GPRS), Transmission Control Protocol/Internet Protocol (TCP/IP), User Datagram Protocol (UDP), Simple Mail Transmission Protocol (SMTP), Simple Network Management Protocol (SNMP), and proprietary message formats.

22. (withdrawn) An electronic payment method utilized by a customer to pay a merchant with a smart card for a remote purchase of a good or service comprising:

placing an order by said customer for said purchase of said good or service to a merchant server via a first network and choosing to pay via a wireless mobile device wherein said wireless mobile device is adapted to access a wireless network and comprises a subscriber identification module (SIM) card slot and a smart card reader/writer module electrically connected to said SIM card slot and wherein said smart card reader/writer module is adapted to receive and read information stored in said smart card without contacting said smart card and transmit said information via said wireless network;

providing said merchant server with an identification information for said wireless mobile device;

creating a digital order comprising purchase information and said identification number for said wireless mobile device by said merchant server;

routing said digital order to an authentication server via said first network;

formatting said digital order into a first message wherein said first message is adapted to be transmitted over said wireless network;

routing said first message over said wireless network to said wireless mobile device;

displaying said first message on said wireless mobile device;

requesting and receiving authorization of payment from the customer via said wireless mobile device;

positioning said smart card in close proximity to said smart card reader/writer module and retrieving smart card identification and security information;

formatting authorization result and smart card identification and security information into a second message and routing said second message to said authentication server;

authenticating and routing said second message to a financial institution, wherein said financial institution is the issuer of said smart card; and

approving and executing said payment at said financial institution.

forwarding said payment approval to said authentication server and from said authentication server to said wireless mobile phone; and

fulfilling said order to said customer by said merchant.

23. (withdrawn) The electronic payment method of claim 22 wherein said good or service comprises a digital good or a digital service and wherein said fulfilling comprises downloading and storing said digital good or service in said smart card.

24. (withdrawn) The electronic payment method of claim 23 wherein said digital good is selected from a group consisting of electronic cash, electronic coupons, electronic gift certificates, electronic transit tokens,, music, software, movies, and books.

25. (withdrawn) The electronic payment method of claim 22 wherein said wireless mobile device is selected from a group consisting of a mobile phone, a personal digital assistant, a pager, a wireless laptop computer, a personal computer, a television remote control, and combinations thereof.

26. (withdrawn) The electronic payment method of claim 22 wherein said wireless network is selected from a group consisting of a wireless wide area network (WWAN), a wireless local area network (WLAN), a private network, and a personal area network (PAN).

27. (withdrawn) The electronic payment method of claim 26 wherein said wireless wide area network (WWAN) is selected from a group consisting of a Global System for Mobile Communications(GSM), a Code Division Multiple Access(CDMA), CDMA 2000, and wideband CDMA(WCDMA).

28. (withdrawn) The electronic payment method of claim 22 wherein said first and second messages comprise a format selected from a group consisting of Short Message Service (SMS), General Packet Radio Service (GPRS), Transmission Control Protocol/Internet Protocol (TCP/IP), User Datagram Protocol (UDP), Simple Mail

Transmission Protocol (SMTP), Simple Network Management Protocol (SNMP), and proprietary message formats.

APPENDIX B

No evidence pursuant to §1.130, 1.131 or 1.132 or entered by or relied upon by the Examiner is being submitted.

APPENDIX C

No related proceedings are referenced in II. Above, hence copies of decisions in related proceedings are not provided.